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EXAMINER
GETZOW,R

33M1/0828

ART UNIT	PAPER NUMBER
3305	2

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DATE MAILED: 08/28/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-33 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-33 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A recording person, in paragraph 2, cannot be claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-6,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen '091.

Allen teaches all of the subject matter of the above claims except an apparatus for recording information, and a comparator. In the examiner's opinion it would have been obvious to give a data entry person the information that was obtained by a physician during a physical examination via an apparatus for recording. Such is

commonplace in a modern medical office. Further, to compare information, as explicitly claimed in claims 5 and 6, in order to reduce error and provide for a more accurate catalog of information on a patient would have been obvious to one of ordinary skill in the art. Still further, the methodology set forth in claim 21 is obvious and commonplace. Physicians typically handwrite information relating to the patient and give this information to a data entry person in order to have a computerized record of the patient's condition as well as health insurance information. Also, it would have been obvious whether one or two people were involved in the examination of the patient and the subsequent recording of information. One person could just as easily have done it.

Claims 7-20,22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen '091 in view of Buchanan et al '155.

Allen teaches all of the subject matter of the above claims except for a recording member with a plurality of recording sections formed thereon and a computer having a plurality of report section templates stored therein. To have a recording member with a plurality of sections thereon would have been obvious in order to allow an orderly and concise representation of data and other information obtained by a physician to be presented to a data entry person. Further, the indicia of Allen are considered to be the predetermined encoded indicia called for in claim 7. Also, Buchanan teaches using a plurality of templates stored in a computer. Such a arrangement would have been

obvious in that, as is taught in Buchanan, one template would not cover all situations or patient conditions. Thus, it would have been obvious to use multiple templates to provide for a greater range of reports that could be generated. Still further, all of the method steps outlined in the above claims are typical and common procedure performed in a variety of physician office settings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Getzow whose telephone number is (703) 308-2997.

Scott Getzow

smg

August 21, 1996